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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,073	12/21/2001	Jean L Lalanne	146.1375	4668
20311	7590	10/13/2004	EXAMINER	
MUSERLIAN AND LUCAS AND MERCANTI, LLP 475 PARK AVENUE SOUTH NEW YORK, NY 10016			KAM, CHIH MIN	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,073

Applicant(s)

FAUVEAU ETAL

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-15,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-15,19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. Claims 1-11, 13-15, 19 and 20 are pending.

Applicants' amendment filed July 27, 2004 is acknowledged. Applicant's response has been fully considered. Claims 1 and 15 have been amended, and claims 12 and 16 have been cancelled. Therefore, claims 1-11, 13-15, 19 and 20 are examined.

Objection Withdrawn

2. The previous objection of claim 1 is withdrawn in view of applicant's amendment to the claim in the amendment filed July 27, 2004.

Rejection Withdrawn

Claim Rejections-Obviousness Type Double Patenting

3. The previous rejection of claims 12, 14-16, 19 and 20 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 8-11, 14 and 17-20 of U. S. Patent 6,677,429 is withdrawn in view of applicant's cancellation of the claim, applicant's amendment to the claim, and applicant's response at page 10 in the amendment filed July 27, 2004.

Claim Rejections - 35 USC § 112

4. The previous rejection of claim 16 under 35 U.S.C.112, second paragraph, is withdrawn in view of applicant's cancellation of the claim, and applicant's response at page 9 in the amendment filed July 27, 2004.

Art Unit: 1653

Claim Rejections - 35 USC § 102

5. The previous rejection of claims 12, 14-16, 19 and 20 under 35 U.S.C. 102(e) as being anticipated by Courtin *et al.* (U. S. Patent 6,677,429) is withdrawn in view of applicant's cancellation of the claim, applicant's amendment to the claim, and applicant's response at page 10 in the amendment filed July 27, 2004.

Claim Rejections-Obviousness Type Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-11 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 8-11, 14 and 17 of U. S. Patent 6,677,429. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-11 and 13 in the instant application disclose a compound of formula I consisting of all possible isomeric forms, where R₁ is hydrogen or methyl, and R₂ is a specific amine- or hydroxy-containing alkyl group (e.g., -CHCH₃CH₂NH₂ or -(CH₂)_aOH, where a is an integer of 1 to 8) or specific heterocyclic-containing alkyl group. This is obvious in view of claims 1, 2, 4, 5, 8-11, 14 and 17 in the patent which disclose a compound of formula I consisting of all possible stereoisomeric forms, where R₁ and R₂ are individually selected from

Art Unit: 1653

the group consisting of hydrogen, OH, alkyl of up to 8 carbon atoms optionally interrupted with oxygen and optionally substituted with halogen, OH and N(-a) (-b), where a and b are individually hydrogen or alkyl of up to 8 carbon atoms. The claim of the instant application and the claims of the patent are directed to a compound of formula I consisting of all possible isomeric forms with R₁ is hydrogen or methyl, and R₂ is an amine- or hydroxy-containing alkyl group. Thus, claims 1-11 and 13 in present application and claims 1, 2, 4, 5, 8-11, 14 and 17 in the patent are obvious variations of a compound of formula I consisting of all possible isomeric forms with R₁ is hydrogen or methyl, and R₂ is an amine- or hydroxy-containing alkyl group.

In response, applicants indicate the present claims are distinct from the compounds disclosed in the Courtin et al. patent, thus, the obviousness type double patenting rejection does not apply (page 10 of the response). The response has been considered, however, the argument is not found persuasive because both the claims of the patent and the claims of instant application encompass the compound of formula I, where R₁ is hydrogen or methyl, and R₂ is an amine- or hydroxy-containing alkyl group. Therefore, the obviousness type double patenting rejection deemed proper.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11, 13-15, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1653

8. Claims 1-11, 13-15, 19 and 20 are indefinite because of the use of the term “all possible isomeric forms and their mixtures”. The term “all possible isomeric forms and their mixtures” renders the claim indefinite, it is unclear what isomers are intended as the possible isomeric forms (e.g., is it a stereoisomer or other isomeric forms), what isomers and how much of each isomer are included in the mixture. Note that the term “consisting of” indicates a Markush group, where a closed language should be used, and “and their mixtures” is open language in regard to the number of components and amounts of each in the mixtures. Claims 2-11, 13-15, 19 and 20 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.

In response, applicants indicate the term “all possible isomeric forms and their mixtures” is definite and is consistent with the use by the Patent Office as indicated in the claims of the Courtin et al. patent (page 9 of the response). The response has been considered, however, the argument is not found persuasive because the claims of the Courtin et al. patent use the term “all possible stereoisomers”, which is different from the term “all possible isomeric forms and their mixtures”; and the cited term does not indicate what isomeric forms are intended for the formula, and what isomers and how much of each isomer are included in the mixture, thus, the term is indefinite.

9. Claim 20 is indefinite because the claim lacks essential steps in the method of treating fungal infection. The omitted step is outcome of the treatment.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1653

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

10. Claims 1-11 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by Courtin *et al.* (U. S. Patent 6,677,429, priority date December 9, 1998).

Courtin *et al.* teach a compound of formula I consisting of all possible isomeric forms, where R₁ and R₂ are individually selected from the group consisting of hydrogen, OH, alkyl of up to 8 carbon atoms optionally interrupted with oxygen and optionally substituted with halogen, OH and N(-a) (-b), where a and b are individually hydrogen or alkyl of up to 8 carbon atoms (column 1, lines 10-54; columns 3 and 4; claims 1, 2, 4, 5, 8-11, 14 and 17 of the patent), which meet the criteria of claims 1-11 and 13, when R₂ is a specific amine- or hydroxy-containing alkyl group (e.g., -CHCH₃CH₂NH₂ or -(CH₂)_aOH, where a is an integer of 1 to 8).

In response, applicants indicate the present claims are distinct from the compounds disclosed in the Courtin *et al.* patent in the definition of R₂, where R₂ is alkylamino or a group of heterocyclic compounds or alkylcyano or other substituents which are not taught by Courtin *et al.* patent (page 10 of the response). The response has been considered, however, the argument is

Art Unit: 1653

not found persuasive because both the patent and the instant application disclose the compound of formula I, where R_1 is hydrogen or methyl, and R_2 is an amine- or hydroxy-containing alkyl group. Therefore, the claimed invention is anticipated by the reference.

Conclusions

12. No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber can be reached at 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

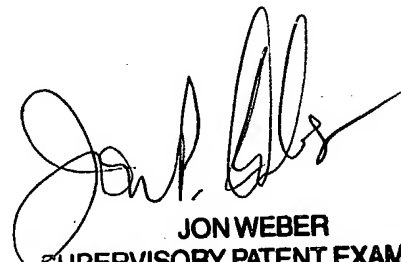
Art Unit: 1653

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

CMK
October 6, 2004



JON WEBER
SUPERVISORY PATENT EXAMINER